

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed December 1, 2004. Through this response, claims 1, 6, 8, 10, 11, 13-15, and 17 have been amended, and claims 15-16 have been cancelled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-14, and 17-19 are respectfully requested.

I. Claim Objections

Claims 6 and 14 have been objected to because of the following informalities, as provided by the Office Action:

“Referring to claim 6, there are two periods, instead of one at the end of the sentence. Appropriate correction is required.

Referring to claim 14, there is not a period at the end of the last sentence. Appropriate correction is required.”

In response to the objection, Applicants have amended claims 6 and 14. In view of the above-noted claim amendments, Applicants respectfully request that the objection be withdrawn.

II. Claim Rejections - 35 U.S.C. § 102(e)

A. Statement of the Rejection

Claims 1-3, 5, 6, 8, and 10-14 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Acosta et al.* (“*Acosta*,” U.S. Pat. No. 6,166,729). Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

It is axiomatic that “[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

Independent Claim 1

As provided in independent claim 1, Applicants claim (with emphasis added):

1. An image capture device comprising:
 - image capture hardware configured to capture an image;
 - a network interface device configured for communication with a communications network; and
 - logic configured to generate a digital image of the captured image comprising image data, *specify at least one display device*, and automatically provide the image data to the communications network for delivery to the at least one specified display device.

Applicants respectfully submit that *Acosta* does not disclose at least the emphasized claim features. *Acosta* discloses the following process (shown below in italics along with citations to the corresponding location in the specification of *Acosta*) implemented to provide image data to a computer through a network and switch facility:

If an incoming broadcast is detected, that broadcast includes the serial ID for the camera 12. The COVMS 16, in a step 506, looks up the serial ID assigned to the camera element 12 making the broadcast in a database of the COVMS 16 containing the serial ID's for all of the camera elements 12 then operating and obtains an IP address for the particular camera element 12. (Col. 17, lines 46-53)

Referring to FIGS. 27-28, in conjunction, once in the steady state of normal operations, a Web Server Communications Manager operation method 1000 implements a round robin queue service utility 1002 that retrieves images from various FIFO queues 1004 and sends them to all required destinations 1006. For each image sent, the Web Server Communications Manager consults the image output mapping table 1008 to determine to whom to send the image. (Col. 23, lines 7-14)

The web site 1050 also includes a user database 1054. The user database 1054 is a database of registered user computers 22. The user database 1054 contains a

complete record of each user computer 22 necessary to provide particular services for which the particular user computer 22 has registered. The user database 1054 also contains information on a preferred display interface, permissions level, records of system usage, and other information for billing purposes for the particular user computers 22. (Co. 26, lines 15-23)

A first interaction by the customer computer 22 with the web site 1050 is to view images from the basic free service, which provides access to some number of public camera element 12 sites. Customer computers 22 which then want to register for one of the service offerings may do so either through the web site 1050 or by calling in to a provided telephone number to have a sysop set up an account. (Col. 28, lines 56-63)

After a client computer 22 logs into the system 10, the computer 22 may request one or more images from the system 10, depending on the service type and choices for the particular computer 22. (Col. 29, lines 50-54)

The system 10 implements security and camera element 12 access control by assigning each installed camera element 12 to one or more permissions group. Each registered user computer 22 of the system 10 is assigned a permissions level which determines which camera elements 12 that computer 22 may access. (Col. 31, lines 30-35)

As is clear from these cited sections from the *Acosta* reference, the camera element 12 provides image data and an ID. However, it is the requesting computer 22 and/or the COVMS 16 that determines which computer 22 receives camera data from a camera element 12. Thus, *Acosta* does not disclose at least ***logic configured to...specify at least one display device***, as recited in independent claim 1.

Because independent claim 1 is allowable over *Acosta*, dependent claims 2-7 are allowable as a matter of law for at least the reason that the dependent claims 2-7 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Independent Claim 8

As provided in independent claim 8, Applicants claim (with emphasis added):

8. An image capture device comprising:
 - means for capturing an image;
 - means for generating a digital image of the captured image, the digital image comprising image data;
 - means for specifying at least one display device to receive the image data;***
 - means for communicating with a communications network; and

means for automatically providing the image data directly to the communications network for delivery to at least one specified display device.

Applicants respectfully submit that *Acosta* does not disclose at least the emphasized claim features. *Acosta* discloses that the camera element 12 provides image data and an ID. However, it is the requesting computer 22 and/or the COVMS 16 that determines which computer 22 receives camera data from a camera element 12. Thus, *Acosta* does not disclose at least *means for specifying at least one display device to receive the image data*, as recited in independent claim 8.

Because independent claim 8 is allowable over *Acosta*, dependent claim 9 is allowable as a matter of law.

Independent Claim 10

As provided in independent claim 10, Applicants claim (with emphasis added):

10. A method for providing automated delivery of digital images, the method comprising:
 capturing an image;
 generating a digital image of the captured image, the digital image comprising image data;
 specifying at least one image display device that is to receive the digital image;
 and
 providing the image data to a communications network for delivery to an image delivery system.

Applicants respectfully submit that *Acosta* does not disclose at least the emphasized claim features. *Acosta* discloses that the camera element 12 provides image data and an ID. However, it is the requesting computer 22 and/or the COVMS 16 that determines which computer 22 receives camera data from a camera element 12. Thus, *Acosta* does not disclose at least *specifying at least one image display device that is to receive the digital image*, as recited in independent claim 10.

Because independent claim 10 is allowable over *Acosta*, dependent claims 11-12 are allowable as a matter of law.

Independent Claim 13

As provided in independent claim 13, Applicants claim (with emphasis added):

13. A method for providing automated delivery of digital images, the method comprising:
- receiving automated image delivery information associated with an image capture device, the ***automated image delivery information configured for specifying an image display device to which a particular digital image is to be delivered***;
 - receiving image data related to a digital image, the image data provided by the image capture device to the communications network;
 - based on the automated image delivery information, determining the image display device to which the image data is to be delivered; and
 - providing the image data to the communications network for delivery to the image display device.

Applicants respectfully submit that *Acosta* does not disclose at least the emphasized claim features. *Acosta* discloses that the camera element 12 provides image data and an ID. However, it is the requesting computer 22 and/or the COVMS 16 that determines which computer 22 receives camera data from a camera element 12. Thus, *Acosta* does not disclose at least “receiving automated image delivery information associated with an image capture device, the ***automated image delivery information configured for specifying an image display device to which a particular digital image is to be delivered***,” as recited in independent claim 13.

Because independent claim 13 is allowable over *Acosta*, dependent claim 14 is allowable as a matter of law.

Independent Claim 17

As provided in independent claim 17, Applicants claim (with emphasis added):

17. An image delivery system for providing automated delivery of digital images, comprising:
- a network interface device configured for communication with a communications network; and

logic configured to:

- receive from an image capture device, via the communications network, automated image delivery information associated with the image capture device, ***the automated image delivery information configured for specifying an image display device to which a particular digital image is to be delivered;***

- receive from the image capture device, via the network, image data related to a digital image;

- determine, based on the automated image delivery information, the image display device to which the image data is to be delivered; and

- provide the image data to the communications network for delivery to the image display device.

Applicants respectfully submit that *Acosta* does not disclose at least the emphasized claim features. *Acosta* discloses that the camera element 12 provides image data and an ID.

However, it is the requesting computer 22 and/or the COVMS 16 that determines which computer 22 receives camera data from a camera element 12. Thus, *Acosta* does not disclose at least “logic configured” to “receive from an image capture device, via the communications network, automated image delivery information associated with the image capture device, ***the automated image delivery information configured for specifying an image display device to which a particular digital image is to be delivered,***” as recited in independent claim 17.

Because independent claim 17 is allowable over *Acosta*, dependent claims 18-19 are allowable as a matter of law.

III. Claim Rejections - 35 U.S.C. § 103(c)

A. Rejection of Claims 4, 7, 9 and 15-19

Claims 4, 7, 9 and 15-19 have been rejected under 35 U.S.C. § 103(c) as allegedly being unpatentable over *Acosta* in view of *Ward et al.* (“*Ward*,” U.S. Pub. No. 2001/0010543A1).

Applicants respectfully traverse this rejection.

B. Discussion of the Rejection

Applicants respectfully assert that the proposed combination is improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in that art the desirability of combining the remote video monitor system of *Acosta* with the digital camera system of *Ward* that downloads a configuration file from a host computer and use the information from that file to manually transmit digital stills over the Internet (see Abstract).

With regard to dependent claim 4, the Office Action alleges the following (with emphasis added):

Acosta does not teach automated delivery information provided by the image capture device (camera) that comprises data for determining at least one specified image display device (computer) to which the image data is to be delivered. Ward teaches a utilization file that is created in the camera to provide information on which and how many images are to be emailed to various recipients (paragraph [0014], lines 13-26). Therefore it would have been obvious to one familiar to the art to combine the image capture device of Acosta to have the "utilization file" that lists email recipients to send images too. One would have been motivated to modify the image capture device of Acosta to include the "utilization file" in that it is desirable to immediately share pictures with friends via email or internet access and it is also desirable to transmit pictures from a location without PC access in order to free up camera storage to take additional pictures as stated in Ward (paragraph [0003], lines 10-14).

Applicants disagree that one would be motivated to modify the image capture device according to *Ward*, and thus submit that the combination is improper. Although a connection may be automatically established in *Ward* (see paragraph [005, line 3]), *Ward* requires that the user manually send the images. Paragraph [0014] of *Ward* provides, "[T]he steps used to automatically transmit images using the network configuration file as shown in FIG. 2." Paragraph [0015] provides, "...the system determines whether a request exists to send an image (step 58)," and "if there is a request to send an image. The user ensures that the camera

is connected to the appropriate service...and pushes a “send” button in the user button selection 26...” This manual transmission system of *Ward* would not work in *Acosta*, and in fact, is a completely different mechanism for image data transmission control. *Acosta* automatically sends the images to the COVMS 16 (col. 7, lines 39-42), the latter which stores the image data. One would not look to *Ward* to modify *Acosta* since, again, their manner of control of image capture and transmission is completely opposite (i.e., *Acosta* requiring instruction from a receiving computer, *Ward* requiring instruction from a sending camera). Besides, *Acosta* already has mechanisms in place to automatically send image data from a remote camera, so the utilization file of *Ward* would not add any feature that was actually useful to the system of *Acosta*. Since there is not suggestion or motivation found in *Acosta* to combine *Ward*, Applicants respectfully submit that the rejection to claim 4 be withdrawn.

Dependent claim 7, which also depends from independent claim 1, also shares limitations with claim 1 and thus for similar reasons explained above, Applicants respectfully request that the rejection to claim 7 be withdrawn.

With regard to dependent claim 9, Applicants disagree that one would be motivated to modify the image capture device according to *Ward*, and thus submit that the combination is improper. Although a connection may be automatically established in *Ward* (see paragraph [005, line 3]), *Ward* requires that the user manually send the images. Paragraph [0014] of *Ward* provides, “[T]he steps used to automatically transmit images using the network configuration file as shown in FIG. 2.” Paragraph [0015] provides, “...the system determines whether a request exists to send an image (step 58),” and “if there is a request to send an image. The user ensures that the camera is connected to the appropriate service...and pushes a “send” button in the user button selection 26...” This manual transmission system of *Ward* would not work in *Acosta*, and in fact, is a completely different mechanism for image data transmission control. *Acosta* automatically sends the images to the COVMS 16 (col. 7, lines

39-42), the latter which stores the image data. One would not look to *Ward* to modify *Acosta* since, again, their manner of control of image capture and transmission is completely opposite (*i.e.*, *Acosta* requiring instruction from a receiving computer, *Ward* requiring instruction from a sending camera). Besides, *Acosta* already has mechanisms in place to automatically send image data from a remote camera, so the utilization file of *Ward* would not add any feature that was actually useful to the system of *Acosta*. Since there is not suggestion or motivation found in *Acosta* to combine *Ward*, Applicants respectfully submit that the rejection to claim 9 be withdrawn.

Although Applicants respectfully disagree with the Office Action analysis pertaining to claims 15 and 16, Applicants' cancellation of claims 15-16 render the rejections to claim 15-16 moot.

With regard to independent claim 17, Applicants disagree that one would be motivated to modify the image capture device according to *Ward*, and thus submit that the combination is improper. Although a connection may be automatically established in *Ward* (see paragraph [005, line 3]), *Ward* requires that the user manually send the images. Paragraph [0014] of *Ward* provides, "[T]he steps used to automatically transmit images using the network configuration file as shown in FIG. 2." Paragraph [0015] provides, "...the system determines whether a request exists to send an image (step 58)," and "if there is a request to send an image. The user ensures that the camera is connected to the appropriate service...and pushes a "send" button in the user button selection 26..." This manual transmission system of *Ward* would not work in *Acosta*, and in fact, is a completely different mechanism for image data transmission control. *Acosta* automatically sends the images to the COVMS 16 (col. 7, lines 39-42), the latter which stores the image data. One would not look to *Ward* to modify *Acosta* since, again, their manner of control of image capture and transmission is completely opposite (*i.e.*, *Acosta* requiring instruction from a receiving

computer, *Ward* requiring instruction from a sending camera). Besides, *Acosta* already has mechanisms in place to automatically send image data from a remote camera, so the utilization file of *Ward* would not add any feature that was actually useful to the system of *Acosta*. Since there is not suggestion or motivation found in *Acosta* to combine *Ward*, Applicants respectfully submit that the rejection to claim 17 be withdrawn.

Because independent claim 17 is allowable over the proposed combination of *Acosta* and *Ward*, dependent claims 18-19 are allowable as a matter of law.

Additionally, because independent claims 1, 8, 10, 13, and 17 are allowable over *Acosta* as explained above, dependent claims dependent claims 2-7, 9, 11-12, 14, and 18-19 are allowable as a matter of law. Further, because *Ward* does not remedy the deficiencies of *Acosta*, Applicants respectfully request that the rejection to claims 4, 7, 9 and 17-19 be withdrawn.

In summary, it is Applicants' position that a proper case for obviousness has not been made against Applicants' independent claim 17, or dependent claims 4, 7, 9, 18-19. Therefore, it is respectfully submitted that each of these claims is patentable over the proposed combination of *Acosta* and *Ward* and that the rejection of these claims should be withdrawn.

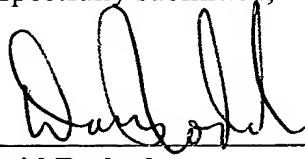
IV. Canceled Claims

As identified above, claims 15-16 have been canceled from the application through this response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be subsequently filed.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'David Rodack', written over a horizontal line.

David Rodack
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